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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/870,590  | 06/01/2001  | Kenichi Moriya       | 35.C10853 Cl/DI     | 4576             |
| 5514  | 7590        | 01/12/2005           | EXAMINER            |                  |
| FITZPATRICK CELLA HARPER & SCINTO<br>30 ROCKEFELLER PLAZA<br>NEW YORK, NY 10112 |             |                      | SCHWARTZ, PAMELA R  |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |

1774

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/870,590

Applicant(s)

MORIYA ET AL.

Examiner

Pamela R. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/15/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-16, 18, 20, 39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-16, 18, 20, 39 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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1. Claims 11-16, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chatwin et al. (5,492,370) for reasons of record and for reasons given below. Applicants argue that the reference is inapplicable because the ink-receiving layer of the reference is opaque. Contrary to applicants' assertions, the reference article appears to be structured in a manner that is consistent with claim 11, i.e. a transparent base that is embossed and metallized on one surface, and an indicia receptive coating on the other surface. The indicia receptive layer is either opaque or translucent. Applicants argue that their ink receptive layer is transparent. This limitation, however, is not recited in claim 11. In fact, applicants' ink receptive layer may contain opaque fillers to the extent that the object of the invention is not hindered. Therefore, complete transparency is not required by applicants and is not claimed.
2. Claims 11 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chatwin et al. (5,492,370) for reasons of record and further in view of Arai et al. (4,664,952). Chatwin et al. disclose an indicia receptive coating that may be used to record with ink droplet printing (i.e. ink jet printing) (see col. 9, lines 25-33). Arai et al. disclose conventional materials for use in recording layers for ink jet recording materials, including polyvinyl alcohol and polyvinyl pyrrolidone (see col. 5, lines 45-58). Since the primary reference does not recite the particulars of the layer, it would have been obvious to one of ordinary skill in the art to utilize well-known coating materials for this layer depending on the type of printer that will be used.
3. Claims 11 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chatwin et al. (5,492,370) for reasons of record and further in view of Maekawa et

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al. (JP355150370A). The primary reference doesn't recite the colors for which printing is performed. Maekawa et al. teach that it is well-known in the art to perform ink jet recording using yellow, magenta and cyan colors. Based upon this teaching, it would have been obvious to one of ordinary skill in the art to record with conventional ink jet recording inks when performing ink jet recording as suggested by the primary reference.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11-16, 18, 20, 39 and 40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner was unable to find support for the new limitation in claim 11, i.e., "when measuring continuously....". The specification supports measurement at four distinct points (see for example, Figures 5-8) but there does not appear to be support for continuous measurement. Clarification is required.

5. Applicant's arguments filed November 15, 2004 have been fully considered but they are not persuasive for reasons set forth above.

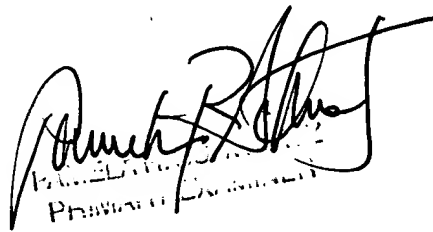
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz  
January 7, 2005



Patricia R. Schwartz  
Patent Examiner